

## REMARKS

As a preliminary matter, the draftsman objected to the drawings. Substitute drawings were submitted in response to the Notice to File Corrected Application Papers dated December 4, 2001. A copy of that response is enclosed herewith. If there are any other objections to the drawings, Applicants will respond under separate cover.

Claims 1-19 are currently pending. Claims 16-19 were allowed by the Examiner and claims 1-15 stand rejected. By this amendment, claims 1, 3 and 4 are amended and claim 7 is cancelled. It is respectfully submitted that all the claims define allowable subject matter.

Claims 1-7, 9, 13-14 stand rejected under 35 U.S.C. §102(b) as being anticipated by *Fascenda et al*, U.S. Patent No. 4,592,546 ("*Fascenda*"). Applicants traverse this rejection and respectfully submit that the pending claims are allowable.

It is well established that anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. As such, for an anticipation rejection, all of the elements and limitations of the claim must be found within a single prior art reference.

Claim 1 is amended to recite "transmitting a play prediction to a scoring database on a game server" among other features; while claim 3 is amended to recite "receiving a next play prediction for a sporting event at a scoring database on a game server" among other features. The *Fascenda* reference does not disclose or suggest at least these claim limitations. Specifically, the Office Action provides that, with respect to claims 16-19, the "art appears to conduct scoring at remote terminal but does not teach/suggest such in conjunction with sending play prediction to a server." (Office Action, page 5, lines 1 and 2). Claims 1 and 3 are amended to include at least these allowable features, and are believed allowable therefore. Claims 2 and 4-7, 9, 13-14 depend from claims 1 and 3 respectively and are believed allowable for all the reasons provided above. Applicants

respectfully submit that the 35 U.S.C. §102(b) rejection of claims 1-7, 9, 13-14 has been overcome.

Claims 8 and 10-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Fascenda* in view of *Everton*, U.S. Patent No. 4,141,548 ("*Everton*") or *Morstain et al*, U.S. Patent No. 4,496,148, ("*Morstain*"). Applicants traverse this rejection.

Applicants respectfully submit that pending claims 8 and 10-12 are allowable. Claims 8 and 10-12 depend from amended independent claim 3, recite additional features thereto and are believed allowable for all the reasons provided above with respect to claim 3. More specifically, neither *Fascenda*, *Everton* nor *Morstain* alone or in combination disclose "receiving a next play prediction for a sporting event at a scoring database on a game server" as recited by claims 8, 10-13 among other features.

It is also respectfully submitted that the Office Action does not provide any motivation to combine *Fascenda* and *Everton* or *Morstain*. The mere fact that the references may be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of such combination. Thus, one cannot merely provide a statement of operability, but must explain why a person of ordinary skill would be motivated to combine the references.

Generally, the "motivation to combine or modify" references includes identifying some missing element or function that calls out for such combination or modification. Otherwise is difficult to set forth a convincing rationale for a person of ordinary skill to be motivated to make the combination or modification, and it would appear that the claims merely are being used as a template.

Specifically, the Office Action provides that "it would have been obvious to an artisan of gaming or sport play prediction at a time prior to the invention to add at least one of a yardage prediction and a scoring prediction, correct yardage prediction, correct scoring prediction, and defensive play outcome as taught by either *Everton* or *Morstain* to *Fascenda*'s game so as to increase the variety of selections and to increase interest in game thereby due to increased interaction." (Office Action, page 3, lines 22-24 and page 4, lines 1-3). Applicants believe that

such statement merely recites some of the features of *Everton* or *Morstain*, and does not identify any missing features in *Fascenda* that calls for its combination with *Everton* or *Morstain*.

Furthermore, *Fascenda* specifically teaches away from its combination with *Everton* (and therefore *Morstain*). *Fascenda* discloses the limitations of *Everton*, stating that the “Everton game is limited by the fact that only the participants viewing a single T.V. receiver in a single room or a residence may participate. Thus, it is not a remote gaming system as is true of the Hedges patent.” (*Fascenda*, col. 1, lines 41-45). As *Fascenda* specifically teaches away from *Everton* (and thus *Morstain*), Applicants submit that the references are not combinable as provided in the office action.

Claim 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Fascenda* in view of Vaughn et al, U.S. Patent No. 5,643,088 (“*Vaughn*”) or Inselberg, U.S. Patent No. 6,434,398 (“*Inselberg*”). Applicants traverse this rejection.

Applicants respectfully submit that pending claim 15 is allowable. Claim 15 depends from amended independent claim 3, recites additional features thereto and is believed allowable for all the reasons provided above with respect to claim 3. More specifically, neither *Fascenda*, *Vaughn* nor *Inselberg* alone or in combination disclose “receiving a next play prediction for a sporting event at a scoring database on a game server” as recited by claim 15 among other features.

It is also respectfully submitted that the Office Action does not provide any motivation to combine *Fascenda* with either *Vaughn* or *Inselberg*. Specifically, the Office Action provides that “it would have been obvious to an artisan at a time prior to invention to add transmitting text information as taught by Vaughn or Inselberg to Fascenda’s game to communicate queries or ads or messages to players.” (Office Action, page 4, lines 13-15). Applicants believe that such statement merely recites some of the features of *Vaughn* and *Inselberg*, and does not identify any missing features in *Fascenda* that calls for the suggested combination.

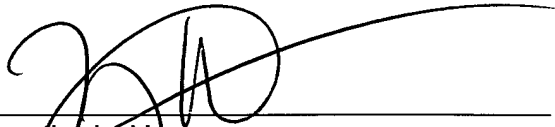
In view of the foregoing, it is respectfully submitted that the pending claims define allowable subject matter. Reconsideration and allowance is respectfully considered.

Please charge any required fees not paid herewith or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Dated: April 14, 2004

Respectfully submitted,  
McAndrews, Held & Malloy, Ltd.

by: \_\_\_\_\_

  
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Enclosure: Copy of the response to the Notice to File Corrected Application  
Papers dated December 4, 2001.